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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/930,235	02/23/1998	ANJA EITRICH	BEIERSDORF45	2748
7055 7590 05/18/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER METZMAIER, DANIEL S	
			ART UNIT 1712	PAPER NUMBER
			NOTIFICATION DATE 05/18/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

Daniel S. Metzmaier

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17, 19, 20, 23, 24, 26, 32, 33, 35-37 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-17, 19, 20, 23, 24, 26, 32, 33, 35-37 and 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 12-17, 19-20, 23-24, 26, 32-33, 35-37 and 41-44 are pending.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The use of the trademark Eusolex® 232 has been noted in this application (example 2). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 12-17, 19-20, 23-24, 26, 32-33 and 35-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claims is indefinite since in claims 12 and 36, the oil phase is set forth with narrow transitional language, i.e., "consisting essentially of", and further set forth with open transitional language, i.e., "comprising".

Allowable Subject Matter

4. The indicated allowability of claims 38-40, now 41-43, is withdrawn in view of applicants' disclosed W/O emulsifiers. Rejections based on the newly cited reference(s) follow. Applicants (page 9 of the instant specification, lines 6-7) assert W/O emulsifiers generally have an HLB of 6-8 and (page 20, lines 10 et seq) include glyceryl monostearate and C₈₋₃₀ fatty alcohols.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 12-17, 19-20, 32-33, 35-37 and 41-43 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McGee et al, US 5,585,343. McGee et al (examples and claim 4) disclose Low VOC perfume formulations as microemulsions.

McGee et al (claim 4; column 4, lines 48-50; and column 6, lines 1-3) discloses sodium laureth sulfate, which is a sodium lauryl ether sulfate as instantly disclosed as the polyethoxylated emulsifiers. McGee et al (column 5, line 29) clearly discloses the use of perfume oils, such as, hydrocarbons are suitable. McGee et al discloses the use of both ethylene glycol monophenyl ether and fatty alcohols in the exemplified compositions. Said materials would have been expected to have W/O emulsifier properties, i.e., a low HLB.

To the extent McGee et al lacks a disclosure of the claimed compositions in sufficient specificity as claimed, McGee et al clearly contemplates the sodium laureth sulfates, hydrocarbons and fatty alcohols. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the sodium laureth sulfate for the exemplified sodium lauryl sulfate in the McGee et al reference.

To the extent McGee et al differs from the claims in the further addition of cosmetic additives to said compositions or the exemplified or disclosed compositions with sufficiency of disclosure, McGee et al clearly discloses the use of cosmetic additives, hydrocarbon perfumes and the use of alkyl ether sulfates as claimed.

McGee et al (column 7, lines 40-46) discloses cosmetic additives reading on those claimed as commonly added formulating ingredients. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ a conventional additives, hydrocarbon perfumes, and alkyl ether sulfates as taught in the McGee et al reference for their art recognized advantageous functions.

McGee et al (column 5, line 29) clearly discloses the use of perfume oils, such as, hydrocarbons are suitable. McGee et al discloses the use of both ethylene glycol monophenyl ether and fatty alcohols in the exemplified compositions. Said materials would have been expected to have W/O emulsifier properties, i.e., a low HLB.

9. Claims 12, 16-17, 20, 23-24, 26, 20-33 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henkel KGaA, DE 4,010,393, (especially Beispiele 1-2, Tabelle 1, and abstract) as evidenced by Schambil et al, US 6,086,787.

Schambil et al is an English language family member of Henkel KGaA as shown by the foreign priority document of Schambil et al, which is the Henkel KGaA application. All remaining citations will refer to the Schambil et al reference hereafter.

Henkel KGaA and Schambil et al (column 1) discloses several prior art cosmetic emulsions as cosmetic creams. The Henkel KGaA and Schambil et al invention is directed to processes of making said emulsions having improved properties.

Henkel KGaA and Schambil et al (column 3-4, lines 66-11) state that their microemulsions are transparent or translucent. This property would appear to be inherent in the patentees' microemulsions.

Furthermore, Henkel KGaA and Schambil et al (column 1, lines 23-31) disclose prior art transparent and bluish opalescence (translucent) as microemulsions. Henkel KGaA and (column 2, lines 4 et seq) disclose the emulsions are formed by phase inversion and are characterized by particularly high particle fineness and stability. Said characterization is known to transparent and translucent microemulsions.

Henkel KGaA and Schambil et al (Table 1 and column 3, lines 52 et seq) disclose the use of glycerol esters of stearic or oleic acids among others. Henkel KGaA and Schambil et al (Table II and column 4, lines 53 et seq) disclose suitable thickeners. Henkel KGaA and Schambil et al (column 4, lines 46 et seq) discloses said glycerol esters are lipophilic consistency generators and would likewise function as the broadly claimed moisture retaining substances. Henkel KGaA and Schambil et al (Table 1 and column 3, lines 52 et seq) further disclose the use of glycerol monoesters of stearic acid and cetyl/stearyl alcohols, i.e., fatty alcohols of 8-30 carbon atoms.

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10. Claims 12-17, 19-20, 23-24, 26, 32-33, 35-37 and 41-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henkel KGaA, DE 4,010,393, (especially Beispiele 1-2, Tabelle 1, and abstract) in view of Schambil et al, US 6,086,787, Rosano, US 4,146,499; with Hoppe et al, US 4,839,165, Unilever PLC, EP 560 516, and/or The Procter & Gamble Company (P & G), EP 616 027. Henkel KGaA and Schambil et al discloses microemulsions as set forth in the above rejection. Said basis is incorporated herein by reference.

Henkel KGaA and Schambil et al differs from the claims in the incorporation of conventional cosmetic ingredients.

Rosano (abstract and column 1, lines 6 et seq) discloses transparent microemulsions and methods of making said microemulsions. Rosano (column 5, lines 11 et seq) discloses the microemulsions may include materials for hair conditioning and skin emollients for use in shampoos, shaving creams and hand soaps. Shaving creams are well known to contain astringents. Rosano (column 5, lines 41 et seq) further discloses the incorporation of organic solvents as conventional ingredients. Rosano (column 9, lines 6-24) discloses the conventional use of at least perfumes or dyestuff in said microemulsions.

These references are combinable since said references teach transparent (i.e., clear) microemulsions having cosmetic use. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ conventional cosmetic ingredients shown and/or implicit in the Rosano reference for their advantageous intended function known to those having ordinary skill in the cosmetic art.

To the extent the claims differ in particular emulsifiers employed, Hoppe et al (examples, particularly example 1, Akypo® RLM 150), Unilever (abstract; page 6, lines 5-8; and claims), and P & G (abstract; page 3, lines 1-10) disclose the use of alkyl ether sulfates or nonionic ethoxylates in combination or alternatively with alkyl ether carboxylates in cleaning and/or hair care compositions.

These references are combinable because they teach cleaning compositions and particularly hair care compositions and the surface active agents suitable therefore. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the alkyl ether carboxylates for the alkyl ether sulfates or nonionic ethoxylates as functional equivalents known in the cleaning art at the time of applicants' invention.

Response to Arguments

11. Applicant's arguments filed 26 February 2007 have been fully considered but they are not persuasive.

12. Applicants (pages 13 and 14) assert the McGee et al reference examples lack the use of the ethoxylated O/W emulsifiers. All disclosures in a reference must be considered for what it fairly teaches those of ordinary skill in the art, not just preferred embodiments or specific working examples. In re Boe, 355 F2d 961, 148 USPQ 507, (CCPA, 1966). In re Chapman, 357 F2d 418, 148 USPQ 711, (CCPA, 1966). In re Mills, 470 F2d 649, 176 USPQ 196, (CCPA, 1972). McGee et al (column 5-6, lines 63-3) clearly discloses the use of alkyl ether sulfates, which were well known at the time of applicants' invention.

13. Applicants (page 14) assert the McGee et al reference lacks a disclosure of the claims as amended. This has not been deemed persuasive since the McGee et al reference clearly discloses (column 5, lines 27 et seq) the perfumes themselves are selected from the usual group of hydrocarbons, which are instantly claimed.

Furthermore, the emollients disclosed in McGee et al are generally known in the art to include either or both of hydrocarbons or a fatty acid triglyceride. Also, the disclosure of other ingredients known to those skilled in the art of formulating cosmetic products would be expected to at least suggest the ingredients claimed, which have not been shown to impart patentable distinction to the claims.

14. Applicants (pages 14 and 15) assert claim 34 was implicitly indicated as allowable since applicants have obviated McGee et al by amendment and claim 34 was not rejected over Henkel as evidenced by Schambil in view of Rosano. This has not been deemed persuasive since the Henkel and Schambil (Table 1) that the microemulsion formed has a viscosity of under 0.1 Pa and is characterized as thinly liquid. Applicants do not specifically define what is a sprayable viscosity or the type of spray device employed to make said compositions sprayable. Thus, it is reasonably concluded that the compositions of Henkel and Schambil clearly disclose, contemplate and/or at least suggest a sprayable microemulsion compositions within the boundaries of their disclosure as instantly claimed.


15. Applicants (page 15) assertion that claims 13-15 and 19 are distinguished over Henkel and Schambil by applicants' amendment are not deemed persuasive for the reasons given above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM